

REMARKS

The September 20, 2007 Official Action withdrew the §101 rejection of the claims but renewed the same prior art rejection set out in previous Actions. Although Applicant appreciates the withdrawal of the rejection under 35 U.S.C. 101, Applicant again traverses the rejection of claims 1-32 under §103. In accordance with the requirements of 37 C.F.R. §§1.111(b) and 1.119, Applicant submits the following comments to distinctly and specifically point out the unsupported nature of these rejections. However, Applicant has previously said almost all that can be said about the differences between the individual claims pending in the captioned application and what is disclosed in the prior art (and those arguments are repeated here as if fully set forth in this Response), so the following comments are directed to the paragraph titled "Response to Arguments."

As noted in the paragraph titled "Response to Arguments" set out on page 2 of the Action, Applicant has argued in past Responses that the *prima facie* showing of the obviousness of the differences between Applicant's claimed invention and Reilly, F.K., "Investment Analysis and Portfolio Management" 3rd Ed., the Dryden Press, Copyright 1989, pp. 165-170, failed for lack of a showing of the required suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference(s) or to combine the teachings of the reference(s). Applicant's argument is addressed in the paragraph titled "Response to Arguments" set out on page 2 of the Action, which alleges that "Reilly suggests that countries have developed composite series which reflect the performance of *all* securities, and that world capital markets are becoming *integrated* – *leading* the world capital indexes [italics in original]." The Action continues by alleging that it would therefore have been obvious "to integrate the *stock index* of Merrill Lynch into the Solomon Brother's index and/or the *money market index* of Solomon Brothers into Merrill Lynch [italics in original]," that one of ordinary skill in the art would be motivated to do so because of "the notoriously old and well known concept of '*diversification*' [italics in original]," and that diversification would have been recognized as being important because it would "provide a more integrated and comprehensive measure of the performance of capital markets of a country and/or various other countries" such that "integration of various indexes would have been an obvious expedient well within the ordinary skill of the art."

Applicant traverses this attempt to provide a showing of the required motivation or suggestion to combine or modify the cited art for several reasons, the first three of which are easy and quick to articulate. The first reason for traversing this attempt to provide a showing of the required suggestion to modify the art is that the grammar and/or syntax of the allegation that "Reilly suggests that countries have developed composite series which reflect the performance of

all securities, and that world capital markets are becoming *integrated* – *leading* the world capital indexes [*italics in original*]” is unclear enough that Applicant is uncertain of its meaning, particularly the meaning of the words after the “dash” in that quotation. The second reason for traversing this attempt to provide a showing of the required suggestion to modify the art is that it highlights something that Applicant has previously emphasized on several occasions, namely, that the art does not teach all the elements of Applicant’s claimed invention. Specifically, this paragraph on page 2 of the Action alleges that it would have been obvious “to integrate the *stock index* of Merrill Lynch into the Solomon Brother’s index and/or the *money market index* of Solomon Brothers into Merrill Lynch [*italics in original*],” but all of Applicant’s claims recite that stock and money market indexes are combined with a bond index, and there is no allegation in this paragraph that Reilly provides any suggestion or motivation to combine stock, money market, and bond indexes. In other words, if one assumed for the purposes of argument that Reilly does suggest everything that this paragraph on page 2 of the Action alleges that it suggests (and Applicant does not admit that it does), Reilly still would not provide this second required element of a proper *prima facie* rejection because it does not suggest combining all three types of indices. The third reason for traversing this attempt to provide a showing of the required suggestion to modify the art is that Applicant does not claim “integrating” “various indexes” as alleged in this paragraph on page 2 of the Action. Applicant (as set out in the claims) instead claims the weighting and combining (not “integrating”) of certain specific indexes (not “various indexes”), the composition of which are recited in detail in some of Applicant’s dependent claims, in accordance with specific mathematical operations, and it is therefore apparent that there is a difference between the modifications that are allegedly suggested in Reilly and what Applicant claims.

The fourth reason that Applicant traverses the showing of a suggestion or motivation to combine or modify Reilly set out in this paragraph on page 2 of the Action is that even if diversification provides a motivation for combining stock and money market indexes as alleged in the Action (and again, Applicant does not admit that it does), the “concept of diversification” does not suggest modifying Reilly in a manner that completely and accurately characterizes the marketplace by including not only multiple classes of assets (stocks, bonds and currencies) as recited in each of Applicant’s independent claims but also by calculating the stock index by assembling either “all or a selected portion of all marketable securities” and calculating the present day market value of those securities as recited in Applicant’s claims 8-10, calculating the bond index by assembling a portfolio of the securities listed in claims 11-12 and 28, or calculating a money market index by assembling a portfolio of instruments as recited in claims 13-14 and 29. Consequently, at least claims 8-14 and 28-29 should be allowed even if the

“concept of diversification” does provide the motivation alleged in this paragraph on page 2 of the Action. Applicant notes that this paragraph of the Action does not even attempt to allege that the “concept of diversification” provides a motivation for calculating each of the stock, bond, or money market indexes in the manner recited in claims 8-14 and 28-29. Applicant therefore respectfully requests withdrawal of the §103 rejection of at least claims 8-14 and 28-29 over Reilly for failure to establish the required showing of a suggestion or motivation to make the invention recited in those claims.

The fifth reason that Applicant traverses the showing of a motivation to modify Reilly set out in this paragraph on page 2 of the Action is that even if diversification provides a motivation for combining stock and money market indexes as alleged in the Action (and again, Applicant does not admit that it does), the “concept of diversification” does not suggest modifying Reilly by weighting indexes in the manner claimed. Applicant’s claim 1, for instance, recites that stock, bond, and money market indices are weighted by a factor that “represents the market value” for each index. There is no allegation in this paragraph on page 2 of the Action that Reilly provides a motivation to modify in this manner. Applicant’s claim 5 goes even further, reciting that the factor for weighting the indices “is determined by calculating the present day market value of each [market] sector and dividing the present day market value of each said sector by the sum of the present day market value of all of the sectors” and claim 32 is even more specific. No indication is given in this paragraph of the Action that Reilly provides a suggestion to modify in the manner recited in either of claims 5 or 32. Applicant’s claim 7 recites the manner in which the indices are weighted in language similar to claim 1, and as noted above, there is no allegation in this paragraph on page 2 of the Action that Reilly provides a motivation to modify in the manner recited in claims 1 or 7. Claims 15, 17-18, and 31 are even more specific in the manner in which the weighting factors are calculated and it does not appear that this paragraph on page 2 of the Action even attempted to suggest that Reilly provides a motivation to modify in the manner recited in any of these claims. It is respectfully submitted that at least claims 5, 15, 17-18, and 31-32 should be allowed even if the “concept of diversification” does provide the motivation alleged in this paragraph on page 2 of the Action. Of course Applicant does not concede that “diversification” provides such a motivation; Applicant also notes that this paragraph of the Action does not even attempt to assert that the “concept of diversification” provides the motivation for calculating weighting factors for the stock, bond, and money market indexes in the manner recited in these claims. Applicant therefore respectfully requests withdrawal of the §103 rejection of at least claims 5, 15, 17-18, and 31-32 over Reilly for failure to establish the required showing of a suggestion or motivation to make the invention recited in those claims.

The sixth reason that Applicant traverses the showing of a motivation to modify Reilly out in this paragraph on page 2 of the Action is that even if diversification provides a motivation for combining stock and money market indexes as alleged in the Action (and again, Applicant does not admit that it does), the "concept of diversification" does not suggest modifying Reilly by calculating an initial period divisor when there is a change of composition of the indices as recited in claim 20 or re-calculating the index as data is revised as recited in claim 21, 24, and 26-27. Nor was any attempt made in this paragraph on page 2 of the Action to identify any such suggestion or motivation in Reilly. It is respectfully submitted that at least claims 20, 21, and 24 should be allowed even if the "concept of diversification" does provide the motivation alleged in this paragraph on page 2 of the Action. Applicant does not concede that "diversification" does provide such a motivation and notes that there this paragraph of the Action does not assert that the "concept of diversification" provides the motivation for calculating an initial period divisor or re-calculating the indexes as recited in these claims two claims. Applicant therefore respectfully requests withdrawal of the §103 rejection of at least claims 20, 21, 24, and 26-27 over Reilly for failure to establish the required showing of a suggestion or motivation to make the invention recited in those claims.

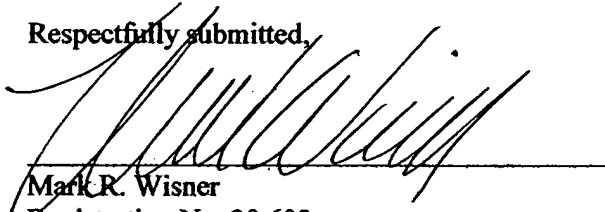
The sixth reason that Applicant traverses the showing of a motivation to modify Reilly set out in this paragraph on page 2 of the Action is that even if diversification provides a motivation for combining stock and money market indexes as alleged in the Action (and again, Applicant does not admit that it does), the "concept of diversification" does not suggest modifying Reilly by summing the multiplication of the index, the market value, and the currency value of each country, computing a divisor by summing the multiplication for each country and dividing to produce a multi-country index as recited in Applicant's claim 25 such that at least claim 25 should be allowed even if the "concept of diversification" does provide the motivation alleged in this paragraph on page 2 of the Action (which Applicant does not admit). Nor is there even an allegation in this paragraph of the Action that the "concept of diversification" provides the motivation for summing the multiplication of the index, the market value, and the currency value of each country, computing a divisor by summing the multiplication for each country and dividing to produce a multi-country index in the manner recited in claim 25. Applicant therefore respectfully requests withdrawal of the §103 rejection of at least claim 25 over Reilly for failure to establish the required showing of a suggestion or motivation to make the invention recited in that claim.

In addition to the requirement that the Office establish that all the elements of a claimed invention are disclosed in the prior art in order to make out a proper *prima facie* rejection under §103 (and as set out above and in past Responses filed in the captioned application, Applicant has

shown that Reilly does not disclose all the elements of Applicant's claimed invention), and in addition to the requirement that the Office establish a motivation to modify the prior art in the manner claimed to make out a proper *prima facie* rejection under §103 (and as set out above and in past Responses filed in the captioned application, Applicant traverses any such allegations), MPEP §2143 requires that a reasonable expectation of success be established to make out a proper *prima facie* rejection under §103. In spite of the fact that Applicant has previously drawn attention to this required third element of a *prima facie* case of obviousness, Applicant is still unable to find so much as an attempt to establish such a showing in the September 20, 2007 Action. Applicant therefore respectfully traverses the §103 rejection of claims 1-27 for this reason as well.

Entry of the above amendments to the claims, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicant's Attorney be contacted at the address and phone number set out below.

Respectfully submitted,



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